

REMARKS

At the time of the First Office Action dated September 26, 2007, claims 1-33 were pending and rejected in this application.

CLAIMS 1-33 ARE REJECTED UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER CLAIMS 1-18 OF U.S. PATENT NO. 6,526,507 (HEREINAFTER THE '507 PATENT)

With regard to Nonstatutory Double Patenting rejections, M.P.E.P. § 804(II)(B)(1) states that

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992). This does not mean that one is precluded from all use of the patent disclosure.

The Examiner's statement of the rejection, however, evidences a complete lack of these factual inquiries in the Examiner's analysis. The Examiner makes conclusory statements

1 regarding what is and is not disclosed by the '507 Patent that is unsupported by factual evidence.
2 Applicants are also unclear why the Examiner is relying on judicially-created grounds for
3 rejecting the claims. Applicants, therefore, respectfully submit that the imposed rejection of claims
4 1-33 under obvious-type double patenting based upon the '507 Patent is not factually or legally
5 viable and, hence, solicit withdrawal thereof.

6
7 **CLAIMS 1-33 ARE PROVISIONALLY REJECTED UNDER THE JUDICIALLY CREATED**
8 **DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER**
9 **CLAIMS 1-36 OF COPENDING U.S. APPLICATION NO. 10/848,796 (HEREINAFTER THE '796**
10 **APPLICATION)**

11 The Examiner's analysis regarding this rejection is equally as deficient as the Examiner's
12 other prior rejection. The Examiner is making conclusory statements regarding what is and is
13 not disclosed by the '796 Patent without setting forth the Graham factual inquiries. In this
14 regard, Applicants note that the analysis and content of a rejection for obvious-type double
15 patenting should be comparable to the analysis and content of a rejection under 35 U.S.C. § 103.
16 Applicants, therefore, respectfully submit that the imposed rejection of claims 1-33 under obvious-
17 type double patenting based upon the '796 Application is not factually or legally viable and, hence,
18 solicit withdrawal thereof.

19
20 **CLAIMS 1-33 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY GLUCK**
21 **ET AL., U.S. PATENT NO. 5,948,104 (HEREINAFTER GLUCK)**

22 On pages 5 and 6 of the First Office Action, the Examiner asserted that Gluck discloses
23 the invention corresponding to that claimed. This rejection is respectfully traversed.

1
2 The factual determination of anticipation under 35 U.S.C. § 102 requires the identical
3 disclosure, either explicitly or inherently, of each element of a claimed invention in a single
4 reference.¹ Moreover, the anticipating prior art reference must describe the recited invention
5 with sufficient clarity and detail to establish that the claimed limitations existed in the prior art
6 and that such existence would be recognized by one having ordinary skill in the art.² As part of
7 this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the
8 meaning of the elements in light of the specification and prosecution history, and (c) identify
9 corresponding elements disclosed in the allegedly anticipating reference.³ This burden has not
10 been met.

11
12 Moreover, the Examiner has failed to clearly designate the teachings in Gluck being
13 relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35
14 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c), which reads:

15 In rejecting claims for want of novelty or for obviousness, the examiner must cite the best
16 references at his or her command. When a reference is complex or shows or describes inventions
17 other than that claimed by the applicant, the particular part relied on must be designated as nearly
18 as practicable. The pertinence of each reference, if not apparent, must be clearly explained and
19 each rejected claim specified. (emphasis added)
20

21 Despite these requirements, the Examiner's statement of the rejection simply consists of
22 the Examiner repeating, almost word-for-word, each of the recited claims and asserting that the
23 entire claim is disclosed by certain specified passages within Gluck. The manner in which the

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

³ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

1 Examiner conveyed the statement of the rejection, however, has not "designated as nearly as
2 practicable" the particular parts in Gluck being relied upon in the rejection.

3
4 It is practicable for the Examiner, for each of the claimed elements, to specifically
5 identify each feature within Gluck being relied upon to teach each of the particular claimed
6 elements. For example, the Examiner can "specifically identify" a feature, corresponding to the
7 claimed element, within the applied prior art by identifying a reference numeral associated with
8 the feature. In addition to or alternatively, the Examiner may cite to a brief passage (i.e., 1 or 2
9 lines or even a portion of a line) within the applied prior art that identifies the feature that
10 corresponds to the claimed element. However, merely citing a long passage or an entire
11 paragraph to disclose entire claims does not designate "as nearly as practicable," the particular
12 features within Gluck being relied upon by the Examiner in the rejection.

13
14 Applicants also note the Examiner's statement in the paragraph spanning pages 6 and 7 of
15 the First Office Action. Notwithstanding that patents are relevant as prior art for all they contain,
16 the Examiner's response must still meet the requirements of 37 C.F.R. § 1.104(c), which requires
17 both specificity in identifying the features in the prior art being relied upon and explanations of
18 the Examiner's analysis. The Examiner's response, however, has not met these requirements.

19
20 The importance of the specificity requirement of 37 C.F.R. § 1.104(c) is evident in
21 M.P.E.P. § 706.07, which states:

22 The examiner should never lose sight of the fact that in every case the applicant is entitled to a full
23 and fair hearing, and that a clear issue between applicant and examiner should be developed, if
24 possible, before appeal.
25

1 A clear issue, however, cannot be developed between Applicants and the Examiner where the
2 basis for the Examiner's rejection of the claims is ambiguous. The Examiner's "analysis"
3 provides little insight as to (i) how the Examiner is interpreting the elements of the claims and
4 (ii) what specific features within Gluck the Examiner believes identically discloses the specific
5 elements (and interactions between elements) recited in the claims. By failing to specifically
6 identify those features within Gluck being relied upon in the rejection, the Examiner has
7 essentially extended Applicants an invitation to engage in mind reading and/or guessing to
8 determine how the Examiner is interpreting the elements of the claims and what specific features
9 within Gluck the Examiner believes identically disclose the claimed invention.

10
11 As noted by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki
12 Co.,⁴ a clear and complete prosecution file record is important in that "[p]rosecution history
13 estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO
14 during the application process." The Courts that are in a position to review the rejections set
15 forth by the Examiner (i.e., the Board of Patent Appeals and Interferences, the Federal Circuit,
16 and the Supreme Court) can only review what has been written in the record; and therefore, the
17 Examiner must clearly set forth the rationale for the rejection and clearly and particularly point
18 out those elements within the applied prior art being relied upon by the Examiner in the
19 statement of the rejection.

20
21 Essentially, the Examiner is placing the burden on Applicants to establish that Gluck does
22 not disclose the claimed elements based upon Applicants' interpretation of the claims and
23 Applicants' comparison of the claims with the applied prior art. However, this shifting of

⁴ 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

burden, from the Examiner to Applicants, is premature since the Examiner has not discharged the initial burden of providing a *prima facie* case of anticipation. Any continuing disagreement between Applicants and the Examiner as to whether or not a particular claimed feature is disclosed by Gluck is a direct result of a lack of specificity in the statement of the rejection.

Claims 1, 18, 20, 26, 31, and 33

Regarding these claims, the Examiner merely cited column 4, lines 5-56 of Gluck. Upon reviewing this cited passage, Applicants note that lines 5-47 merely describe the components of a computer system and do not appear to be particularly relevant to the recited claim language. For ease of reference column 4, lines 48-56 of Gluck is reproduced below:

The interrupt vectors are generated during initialization (i.e., boot up) of the computer system 10 by execution of the BIOS. Because responses of the CPU 20 to device interrupts may need to be changed from time to time, the interrupt vectors may need to be modified from time to time in order to direct the CPU 20 to different interrupt handling routines. To allow for modification of the interrupt vectors, they are stored in the RAM 30 during operation of the computer system 10.

Claim 1, for example recites receiving a software fix from a fix server. However, the Examiner's cited passage is completely silent as to these limitations. The Examiner's cited passage is also completely silent as to the claimed "the client computer communicates only with the fix server." In fact, the Examiner cited passage does not even discuss the client computer communicating with any other computer. The Examiner, therefore, has failed to establish that Gluck identically discloses the claimed invention, as recited in claims 1, 18, 20, 26, 31, and 33 within the meaning of 35 U.S.C. § 102.

Claims 6-7, 10, 25, and 30

The Examiner's sole citation of column 4, line 5 through column 5, line 5 is equally as unenlightening as to the Examiner's rationale for rejecting the claims as the Examiner's prior

1 citation. Column 4, line 57 through column 5, line 5 also only describe commonly known
2 features of a computer device and the relevance of these cited passages to the specific language
3 of the claims is completely unclear to Applicants. Thus, the Examiner has further failed to
4 establish that Gluck identically discloses the claimed invention, as recited in claims 6-7, 10, 25,
5 and 30 within the meaning of 35 U.S.C. § 102.

6
7 Claims 2-3, 5, 11-13, 15-17, and 19

8 The Examiner's sole citation of column 5, lines 551 is again equally unenlightening as the
9 Examiner's prior citations. Column 5, lines 4-51 only describes that a virus scanner within a
10 computer system scans for virus in a manner that is well-known in the art. The Examiner's cited
11 passage is completely silent as to (i) a software fix; (ii) a broadcasted packet; (iii) an isolator; (iv)
12 a secondary operating system; (v) rebooting; and (vi) pre-booting among other cited limitations.
13 Thus, the Examiner has further failed to establish that Gluck identically discloses the claimed
14 invention, as recited in claims 2-3, 5, 11-13, 15-17, and 19 within the meaning of 35 U.S.C. §
15 102.

16
17 For above-described reasons, the Examiner has failed to establish that Gluck identically
18 discloses the claimed invention, as recited in claim 1-33, within the meaning of 35 U.S.C. § 102.
19 Applicants, therefore, respectfully submit that the imposed rejection of claims 1-33 under 35 U.S.C.
20 § 102 for anticipation based upon Gluck is not factually viable and, hence, solicit withdrawal
21 thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500563, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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